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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,317	01/12/2006	Hiroyuki Kikkoji	277147US6PCT	7397
22850	7590	11/02/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
HUYNH, NAM TRUNG				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
11/02/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/564,317

**Applicant(s)**

KIKKOJI ET AL.

**Examiner**

NAM HUYNH

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 9, 12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/1/09 has been entered.

### ***Response to Amendment***

This office action is in response to amendment filed on 9/1/09. Of the previously presented claims 1-5, 9, 12, and 14-17; claims 1, 3, 4, 9, 12, 14, and 17 were amended and claim 18 has been added.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 9, 12, and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the claim is indefinite for several particular reasons. The first reason is that the claim recites a transmission means transmits user personal information in order to **“request a user registration”** (line 5). In the following limitation, detection means detect whether user personal information is stored in a medium when an **“access request”** (line 7) is made to the external device. In the following limitation, the same or another (the Examiner is uncertain) transmission means transmits **“request information”** (line 9). It is indefinite whether these requests are the same request, three separate requests, or a combination thereof.

The second reason is that in lines 14-15, the second recited transmission means is capable of “receiving said information in a reply to said available/unavailable request information”. This recitation is indefinite because by definition a **“transmission means”** is not capable of receiving information and it is unclear whether the **“information”** refers to the available/unavailable request information or the related information about the contents.

The third reason is that the preamble recites **“A communication apparatus for receiving related information about contents, comprising:”** (lines 1-2) and that **“an external device provides related information about contents”** (lines 3-4). These two limitations imply that the communication apparatus is a user device that contains all the recited means. However, a user device comprising the notification means is indefinite because a user device **“requesting”** information from an external device is not going to notify itself about the information requested. Furthermore, a user device comprising the detection means is also indefinite because if the **“access request”**

associated with the detection means is the same as the “**request for registration**” associated with the transmission means, there is no possible way the user personal information can be transmitted without being stored in one way or another. Based on dependent claim 2, it appears that the notification means is a component of the external device and if the detection means was also a component of the external device the claim would make a little bit more sense but the Examiner is uncertain. Accordingly the claim will be examined with respect to prior art under the assumption that the detection means and notification means are components of the external device which is the Examiner's best understanding of the claim language.

Regarding claims 9, 12, 14, and 17, the limitations are rejected as applied to claim 1.

Regarding claims 2-4, 15, 16, and 18, the limitations are rejected based on their dependence of independent claims 1 and 9.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-5, 9, 12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman et al. (US 2002/0174431) in view of AARNIO (US 2002/0174431).

Regarding claim 1, Bowman teaches a communication apparatus (mobile device or computer) for receiving related information about contents (paragraph 20), comprising:

transmission means for transmitting user personal information (user ID code) to an external device (DPS) (paragraph 24) that provides related information about contents (song title and weblink for retailer) (paragraph 27) included in broadcast information received by the communication apparatus (paragraph 18), in order to request a user registration (paragraph 2388; user registers with DPS);

detection means for detecting whether or not said user personal information has been stored in a storage medium, when making an access request is made to said external device (paragraph 25; DPS reviews user ID code validity);

transmission means for transmitting request information that requests said related information about the contents (paragraph 24; user transmits bookmark), for transmitting available/unavailable request information that requests information showing whether or not said external device offers a service providing said related information about the contents, and receiving said information in a reply to said

available/unavailable request information (paragraph 27, DPS responds with available information regarding song of interest indicated in bookmark); and

notification means for notifying information concerning the service, providing said related information about the contents, offered by said external device (paragraph 27, DPS responds with available information regarding song of interest indicated in bookmark).

However, Bowman does not explicitly teach that the available/unavailable request information is transmitted if the transmission means detects that said user personal information is not detected by said detection means stored in said storage medium. AARNIO discloses an on-line subscription system and method. AARNIO teaches the request for registration of a user if user specific information is not previously stored (paragraph 23). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Bowman to include the capability to request registration when user personal information is not stored, as taught by AARNIO, in order to promote registration which benefits the user and subscription service provider because the user is able to access the service and the provider is able to profit from the registration.

Regarding claim 2, Bowman teaches said notification means notifies whether or not said external device offers the service providing said related information about the contents (paragraph 27).

Regarding claims 3 and 15, AARNIO teaches display means for displaying advertisement information to promote said user registration in accordance with a reply to said transmitted available/unavailable request information (paragraphs 23, 25).

Regarding claim 4, AARNIO teaches a URL showing advertisement information to promote said user registration is included in a reply to said transmitted available/unavailable request information (paragraph 23).

Regarding claims 5 and 16, Bowman teaches said user personal information includes at least name information corresponding to a name of said communication apparatus (paragraphs 24, 25).

Regarding claims 9, 12, and 17, the limitations are rejected as applied to claim 1.

Regarding claim 18, AARNIO teaches storage means for storing said user personal information in said storage medium upon a reception of registration completion information (paragraphs 23, 26; after a user registers the information is stored in the subscription service because the user is now a subscriber).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-5, 9, 12, and 14-18 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/  
Supervisory Patent Examiner, Art Unit 2617

/Nam Huynh/  
Examiner, Art Unit 2617